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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 11

Application Number: 09/466,271

Filing Date: December 17, 1999

Appellant(s): Iran M. Drysdale

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GROUP 3600

Thomas W. Saur

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/28/03.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

The brief contains a statement that there are no other appeals and interferences that related to the instant application.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5)   Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7)   Grouping of Claims

Appellant's brief includes a statement that claims 1-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,850,442	MUFTIC	12-1998
5,987,498	ATHINGS et al.	11-1999

(10)   Grounds of Rejection

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

. Claims 1-3, 5-15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Muftic

(U.S. Patent No. 5,850,442).

Claims 1 and 12:   Muftic discloses a service terminal and a method of performing a card transaction, the method comprising:

accessing a web server using a transaction device, wherein the web server includes commands for processing the transaction (Col. 9, lines 15-55); and

entering a transaction card into a card reader of the transaction device in order to enter transaction information associated with the card into the web server (Col. 10, lines 23-55). Muftic does not explicitly disclose that the transaction device/the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction.

However, Muftic clearly discloses that one of the advantages of the invention is "to permit world wide electronic commercial transactions to be implemented in a highly secure manner over an open network." (Col. 5, lines 38-41, emphasis added. Thus, it would have been within the level of ordinary skill in the art to install proprietary software to a merchant service provider server "to permit world wide electronic commercial transactions" by using transaction devices/point of service terminals "over an open network". Further, in this configuration, the transaction devices/point of service terminals would not utilize proprietary software of a merchant service provider to complete the transaction.

Claim 2:   Muftic discloses the method of claim 1 wherein accessing a web server comprises accessing a web page of the web server, and wherein the web page includes commands for processing the transaction (Col. 10, line 56-col. 12, line 4).

Claim 11:   Muftic discloses a method of performing a card transaction, the method comprising:

accessing a web server using a point of service terminal having a web browser and a card reader, wherein the web server includes commands for obtaining authorization of the transaction (Col. 9, lines 15-55, Col. 10, lines 23-55, and col. 12, lines 39-58);

entering a transaction card into the card reader in order to enter an account number associated with the card into the web server and responding to prompts generated by the web server using the terminal (Col. 12, line 53-col. 14, line 19); and

obtaining authorization for the transaction through the web server (col. 12, lines 39-58); wherein the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction.

Muftic does not explicitly disclose that the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction. However, Muftic clearly discloses that one of the advantages of the invention is "to permit world wide electronic commercial transactions to be implemented in a highly secure manner over an open network." (Col. 5, lines 38-41, emphasis added. Thus, it would have been within the level of ordinary skill in the art to install proprietary software to a merchant service provider server "to permit world wide electronic commercial transactions" by using transaction devices/point of service terminals "over an open network". Further, in this configuration, the point of service terminals would not utilize proprietary software of a merchant service provider to complete the transaction.

Claims 3 and 13:   Muftic discloses a service terminal and a method of claims 1 and 12. Muftic also discloses entering additional transaction information into the web server (Col. 13, line 11-col.16, line 40).

Claim 6:   Muftic discloses the method of claim 1. Muftic also discloses the displaying information on a display device of the transaction device (Col. 18, line 11-col. 19, line 49).

Claims 7, 8 and 15:   Muftic discloses the terminal and the method of claims 6 and 12. Muftic also discloses the displaying information includes displaying an electronic coupon and an advertisement downloaded from the Internet (Col. 20, line 19-col. 21, line 17)

Claims 9 and 10:   Muftic discloses the method of claim 1. Muftic also discloses obtaining authorization for the transaction through the web server and updating the commands of the web server(Col. 12, line 5-col. 14, line 62).

Claims 5 and 14:   Muftic discloses the terminal and the method of claims 3 and 14 wherein entering additional transaction information. However, Muftic does not specifically disclose entering the additional transaction information using a keypad of the transaction device. Official Notice is taken that it is old and well known within the computers art to use a keypad of the transaction device (see Microsoft Computer Dictionary, p335). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a keypad of the transaction device. One would have been motivated to use a keypad in order to facilitate easy data insertion, access, and update.

Claim 17:   Muftic discloses that the card transaction involves a smart card (e.g., see col. 1, line 20).

Claims 18 and 19:   Muftic discloses the point of service terminal is being at a retail location and transmitting information to and from a merchant service provider (e.g., see col. 4, lines 60-65).

6.   Claims 4, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (U.S. Patent No. 5,850,442) in view of Athing et al. (U.S. Patent No. 5,987,498).

Claims 4 and 16:   Muftic discloses the terminal and the method of claims 3 and 15 wherein entering additional transaction information. However, Muftic does not specifically disclose includes entering the additional transaction information using a touch sensitive screen of the transaction device. Athing discloses such step (Col. 9, line 44-col. 11, line 18, and col. I, line 28-col. 13, line 23).

Claim 20:   Muftic further discloses the step of providing an electronic signature (e.g., col. 14, line 45) without explicit disclosure of using a pen and the touch-sensitive screen. However, as shown by

Athing, the use of a touch-sensitive screen is well known and the use of an electronic pen is also well

known in the art. Thus, it would have been within the level of ordinary skill in the art to employ these

well-known features to the method of Muftic to further facilitate a card transaction over an open network.

(11) Response to Argument

Issue 1

This is in response to appellant's brief on appeal filed on 8/28/03. In view of appellant's

argument, the rejection of claim 21 under 35 USC 112 first paragraph has been withdrawn.

Issue 2

Group 1 (claims 1-10, and 17-21)

The Final Office Action mailed 3/25/03 conceded that Muftic does not explicitly discloses the steps of the

claims but it is clear that the reference implicitly covers all it. Consequently, regarding appellant's

assertion that Muftic does not disclose the transaction device which does not utilize proprietary software

of a merchant service provider to complete the transaction (Page 9, bottom), the Examiner notes that

Appellant's interpretation of Muftic is incorrect. More specifically, it is true that Muftic discloses the use of

smart token technology software. However, the smart token technology software disclosed by Muftic is

not the proprietary software of a merchant service provider (i.e., software of credit companies) but a

software used for world wide electronic commerce system to enhance the security of transaction over an

open network (i.e., the smart token technology software disclosed by Muftic a proprietary software of a

software company which produced but not the proprietary software of a merchant service provider). In

fact, Muftic discloses: "Another advantage of the invention lies in providing a consistent application

programming interface which can be utilized in all types of transactions for ensuring security and

authenticity of the certified products." (Col. 6, lines 49-52).

Furthermore, Muftic discloses: "In one embodiment, the servers are world wide web servers and

the user terminals run web browser software such as Mo. The security servers links all registered users

into a public key infrastructure. Information about the contents of servers may be obtained using an indexing system. The indexing system may be a white pages directory, a yellow pages directory or the indexing system may be generated by a webcrawler." (Col. 7, lines 16-23).

Moreover, Muftic discloses: "This allows the user, be it an individual or software routine, to invoke security and card reading capabilities using a standard consistent interface without concern for how the particular functionality is implemented for each of the primitives. World wide web server software 230 represents any one of several standard commercial packages available for equipping a computer with world wide web server functionality." (Col. 10, lines 3-10).

Thus, Muftic clearly implies a method of performing a card transaction that provides for accessing a web server using a transaction device, wherein the transaction device does not utilize proprietary software of a merchant service provider to complete the transaction. Consequently, the rejection of Claim 1 should be sustained as well as for the claims which depend from claim 1.

Group B (Claim 11)

Appellant's states that: "Muftic fails to disclose the features related to the point of service terminal that does not utilize proprietary software of a merchant software provider to complete the transaction " (Page 11, lines 10-12). As discussed above this features are implicit in Muftic's invention, as it's clear from the support quotation s of the reference.

In reference to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant application, Athing clearly shows equivalent GUI structures (e.g. column 11, lines 7-18) known in the art and it would have been within the

level of ordinary skill in the art to employ any known GUI structure including a touch-sensitive screen as shown by Athing as desired in a network for transactions.

Group C (Claims 12-16)

The Final Office Action mailed 3/25/03 conceded that Muftic does not explicitly discloses the steps of the claims but it is clear that the reference implicitly covers all it. As discussed above the features of claim 12 are implicit in Muftic's invention, as it's clear from the support quotation s of the reference.

Issue 3 (claims 4, 16, and 20)

Regarding claim 20, the Examiner point out in reference to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant application, Athing clearly shows equivalent GUI structures (e.g. column 11, lines 7-18) known in the art and it would have been within the level of ordinary skill in the art to employ any known GUI structure including a touch-sensitive screen as shown by Athing as desired in a network for transactions.

Thus, the combination of the Athing teaching with the Muftic patent covers the of claims of the instant application, and, consequently, the rejection should be sustained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

PRK

November 28, 2003

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